

PATENT/Docket No. PC11050A
Appl. No. 09/989,933
Filing Date: 11/21/2001

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REMARKS

I. Preliminary Remarks

In the Office Action, Claims 30-76 are pending and under examination. All claims are subject to a requirement for restriction. After entry of this paper, Claims 30-41, 46, 47, 54, 55, 60-68, 73, and 74 are under consideration. Claims 42-45, 48-53, 56-59, 69-72, 75, and 76 are withdrawn, with traverse and without prejudice in an effort to favorably advance prosecution of the present application. Applicants reserve the right to petition for rejoinder should the circumstances allow, or to pursue the subject matter of the withdrawn claims in a divisional application. However, reconsideration and withdrawal of the restriction requirement are solicited for the reasons set out below.

This Response addresses the Examiner's restriction requirement. Applicants therefore respectfully submit that the present application is in condition for examination on the merits. Favorable consideration of all pending claims is respectfully requested.

This Response is timely filed. The USPTO is given authorization to charge Deposit Account No. 21-0718 for any fees necessary with the submission of this Response.

II. Remarks/Arguments

In the Office Action, the Examiner has set forth a requirement for restriction under 35 U.S.C. §121, alleging that the subject matter defined by the claims of the present invention represents the following six separate and distinct inventions:

Group I. Claims 30-41, 46, 47, 54, 55, 60-68, 73, and 74, drawn to an attenuated bovine viral diarrhea virus (BVDV) and nucleic acids encoding such, classified in class 435, subclass 235.1.

Group II. Claims 42-45, drawn to methods for the modification of a BVDV genomic nucleic acid, classified in class 435, subclass 440.

Group III. Claims 48, 50, 52, 56, 69, 71, and 75, drawn to methods of inducing an immune response in an animal through administration of an attenuated BVDV, classified in class 424, subclass 218.1.

Group IV. Claims 49, 51, 53, 57, 70, 72, and 76, drawn to methods of inducing an immune response in an animal through administration of nucleic acid encoding an attenuated BVDV, classified in class 536, subclass 23.72.

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Group V. Claim 58, drawn to methods of determining if an animal is infected with an attenuated BVDV comprising isolating the virus and determining the presence of a mutated Npro sequence therein, classified in class 435, subclass 6.

Group VI. Claim 59, drawn to methods of determining if an animal is infected with an attenuated BVDV comprising isolating the virus genome and determining the presence of a bovine ubiquitin sequence therein, classified in class 435, subclass 6.

In order to be fully responsive to the Examiner's requirement for restriction, Applicants provisionally elect, with traverse, to prosecute the subject matter of Group I, Claims 30-41, 46, 47, 54, 55, 60-68, 73, and 74, drawn to an attenuated bovine viral diarrhea virus (BVDV) and nucleic acids encoding such, classified in class 435, subclass 235.1.

Applicants conditionally withdraw Claims 42-45, 48-53, 56-59, 69-72, 75, and 76 without prejudice. Applicants reserve the right to petition for rejoinder should the circumstances allow, or file one or more divisional applications directed to the non-elected subject matter in this Application.

The courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicant has done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl 456 F.2d 658, 666, 117 U.S.P.Q. 250,256 (CCPA 1973). This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

In addition, Applicants observe that Groups I-VI are all directed to similar subject matter. Therefore, it is respectfully submitted that it would not constitute undue burden on the Examiner for the claims of all the groups to be maintained in a single application and for all six groups to be examined together. It is respectfully submitted that prosecution of all of these groups of

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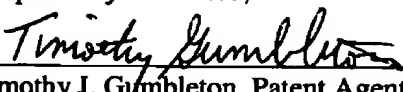
claims in a single application would be efficient, thereby promoting the grounds for the establishment of the restriction requirement practice.

Applicants further respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), applicants are required to conduct simultaneous prosecution, as here, requiring excessive filing costs or to otherwise compromise the term of related patent assets.

III. Conclusion

In view of the foregoing comments, it is respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,



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